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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,133	03/24/2004	Jean-Luc Perillon	1759.157	4558
23405	7590	05/18/2006		
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203				
			EXAMINER	
			RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 05/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/808,133

Applicant(s)

PERILLON ET AL.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicant's response filed March 2, 2006. The rejections have been maintained.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al. (US 5,707,904) in view of Crouch et al. (US 5,895,705) and Paquette et al. (US 5,229,207). Gray et al. disclose a fabric for use as an awning comprising a woven scrim and a translucent coating on at least one side of the scrim (col 1, ln 53-54). The translucent coating is preferably plastisol and the scrim is formed of woven polyester yarns (col 1, ln 60-65). As seen in Figure 2, the scrim (reference point 30) is coated with an upper plastisol layer (reference point 20) and a lower plastisol layer (reference point 14). The plastisol layer is preferably a vinyl plastisol including a PVC resin and plasticizers (col 3, ln 1-4). A release paper (reference point 12) is also included in the fabric laminate. Gray et al. disclose the claimed invention except for the teaching that the laminate comprises a varnish layer and a repositionable pressure sensitive adhesive layer.

Crouch et al. (US 5,895,705) disclose an awning fabric comprising a varnish, i.e. acrylic resin, that is used in the ink, which further contains pigments (col 3, ln 24-33). The varnish is on the surface of a PVC plastisol coating layer that coats the fabric (col 3, ln 39-40).

Paquette et al. (US 5,229,207) disclose a film composite comprising a substrate useful in awnings (col 2, ln 7-9) and further comprising a layer of adhesive which is pressure sensitive (col 1, ln 68) and affords good repositionability (abstract).

It would have been obvious to one having ordinary skill in the art to have incorporated Crouch's varnish layer in the laminate of Gray et al. and Paquette, motivated by the desire to create a laminate that has ease of printing and has increased stiffness.

It also would have been obvious to have incorporated Paquette's repositionable pressure sensitive adhesive in the laminate of Gray et al. and Crouch, motivated by the desire to create laminate that has ease of handling and maneuverability.

Regarding claim 5, although Gray et al., Crouch et al., and Paquette et al. do not explicitly teach the claimed adhesive force, it is reasonable to presume that this property is inherent to the invention of Gray et al., Crouch et al., and Paquette et al.. Support for said presumption is found in the use of like materials (i.e. scrim coated on both sides with a PVC plastisol, a varnish one side, a repositionable pressure sensitive adhesive on the other side, and release paper). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a pressure sensitive adhesive layer possessing an adhesive force between 1 and 100 Newton, for a strip with a width of 5 cm, would obviously have been present once the Gray et al., Crouch et al., and Paquette et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

***With regard to Applicant's "capable of" limitations in lines 1 and 5 of claim 1, it has been held that a recitation that an element is "capable of" performing a function is not a***

***positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.***

***Rejection is maintained.***

4. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray et al. (US 5,707,904), Crouch et al. (US 5,895,705), and Paquette et al. (US 5,229,207), as applied to claim 1 above, and further in view of Edwards et al. (US 6,037,280). Gray et al., Crouch et al., and Paquette et al. disclose the claimed invention except for the teaching that the coating layers comprise UV blocking metallic particles.

Edwards et al. (US 6,037,280) disclose a fabric awning comprising UV blocking metallic particles (abstract and col 2, ln 34-35). It would have been obvious to one having ordinary skill in the art to have used Edwards' UV blocking metallic particles in the coating layers of Gray et al., Crouch et al., and Paquette et al., motivated by the desire to create an awning fabric that is resistant to UV light and has the desired aesthetics and pigmentation.

***Rejection is maintained.***

#### ***Response to Arguments***

5. Applicant's arguments filed March 2, 2006, have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that there is no suggestion or motivation to make the varnish layers of Crouch "capable of being printed." As shown above, it has been held that a recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the rejections are maintained.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UCR *UCR*

*Ula Ruddock*  
**Ula C. Ruddock**  
Primary Examiner  
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